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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/601,390
Filing Date: June 23, 2003
Appellant(s): EMALFARB, BRADLEY

John S. Mortimer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 Nov 2011 appealing from the Office action mailed 23 Feb 2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-22.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,897,786	Kalt et al.,	6-2000
4,015,349	Dunne	2-1999
6,267,529	Mudryk et al.,	5-1999

Purdy, Matthew "Turnpike: Doing what it does best?" New York Times, NY, NY, Nov 7, 1999, pp. B37

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: This is a substantially accurate copy of the non-final rejection mailed 23 Feb 2011.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-13, 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Dunne (4,015,349) further in**

view of Turnpike: Doing What It Does Best?, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike").

As per claims 1, 13, Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support on or adjacent to a public right-of-way, the public right-of-way including at least one lane for vehicle traffic to move in a first direction and a second lane spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction (column 1, lines 25-40);

providing a first type of information on the support, the first type of information placed in a manner that the first type of information is viewable by an occupant of a vehicle in the one lane moving in a first direction and facing generally in the first direction (column 1, lines 25-40).

Kalt does not explicitly disclose the information is maintained and/or regulated by a federal or local authority; and

the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way.

However, Dunne discloses information maintained and/or regulated by a federal or local authority; and

the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way (col. 3, ln. 30-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Dunne's highway overhead information maintained by the government to Kalt's highway overpass traffic signs. One would be motivated to do this in order to provide motorists with traffic information.

Kalt does not explicitly disclose providing advertising information that is different type than the first type of information, on the support for and entity that is not the federal or local authority that maintains and /or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction ; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity.

However, Turnpike discloses providing advertising information that is different type than the first type of information, on the support for and entity that is not the federal or local authority that maintains and /or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity

(page B 37, where two sided billboards offer advertisement for turnpike traffic at a cost to advertisers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Turnpike's two sided billboards to Kalt's highway overpass traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

As per claim 2, Turnpike further discloses the step of providing advertising information comprises providing the advertising information on a substantially flat, first display surface facing in the first direction (page B37).

As per claim 3, Kalt further discloses the step of providing information comprises providing a first type of information on a substantially flat, second display surface facing oppositely to the first direction (column 1, lines 25-40).

As per claim 4, Turnpike further discloses the step of illuminating the advertising information (page B37).

As per claims 5-8, 16-19, Kalt further discloses providing a first type of information on a first display surface that is on the support in an elevated position and at least partially directly over the one lane (column 1, line 64 - column 2, line 16, the sign is disclosed to be mounted on overpasses of highways which is equivalent to at least one traffic lane).

As per claims 9-12, 20-22, Turnpike further discloses providing a first type of information on a first display surface with a first area on the support, and the step of providing advertising information comprises providing advertising information on a

second display surface with a second area on the support so that the first and second areas overlap both sideways and in a vertical direction (page B37).

As per claim 15, Kalt discloses there is a first shoulder region to a side of the first and second lanes opposite to the one side and the step of providing the second display system comprises providing the second display system at least partially directly over the first shoulder region (column 1, line 64 - column 2, line 16, where near the roadway is equivalent to shoulder region).

3. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Dunne (4,015,349) further in view of Turnpike: Doing What It Does Best?, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike") further in view of Mudryk et al., (6,267,529).**

As per claim 14, the Kalt, Dunne and Turnpike combination discloses the claimed invention as in claim 13. The combination does not disclose there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median.

However, Mudryk discloses there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median (column 1, lines 15-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mudryk's highway median sign to Kalt's highway

traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

(10) Response to Argument

Examiner notes that the combination of the prior art renders obvious the features of the Appellant's independent claim 1:

A method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support on or adjacent to a public right-of-way that is maintained and/or regulated by a federal or local authority, the public right-of-way including at least one lane for vehicle traffic to move in a first direction and a second lane spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction (Kalt, col. 1, ll. 25-40);

providing a first type of information on the support, the first type of information placed in a manner that the first type of information is viewable by an occupant of a vehicle in the one lane moving in a first direction and facing generally in the first direction (Kalt, col. 1, ll. 25-40);

the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way (Keach, par [0009-0011])

placing advertising information, that is a different type than the first type of information, on the support for an entity that is not the federal or local authority that

maintains and/or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction (Turnpike B37); and

charging a fee to the entity to allow the advertising information to be maintained on the support by the entity (Turnpike, page B37).

And, the preceding is obvious in light of the rejection above.

Ground 1 On page 6 of Appeal Brief, Appellant states that "...the claimed method has no disqualifying characteristic that manifestly exhibits itself so as to be ineligible for patent protection." "Accordingly, it is respectfully submitted that the rejection of claims 1-22 under 35 U.S.C. § 101 is improper."

After careful review of the Appellant's argument, examiner maintains the 101 rejection for the following two reasons:

1. No significant step is tied to a processor or machine.
2. The claims as a whole are directed to an abstract idea.

Examiner further notes that since claims 1 and 13, independent claims are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

According to the July 2010 Guidelines, some of the factors weighing against patent eligibility under 35 U.S.C. 101 include:

- No machine/No transformation
- Insufficient machine/transformation
- Machine is merely acted upon
- Transformation involves only a change in position or location of article

The Office has been using the machine-or-transformation test used by the Federal Circuit to evaluate whether a method claim qualifies as a statutory patent-eligible process. See Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. 101 dated August 24, 2009. The Supreme Court stated in *Bielski* that the machine-or-transformation test is a "useful and important clue" and "investigative tool" for determining whether some claimed methods are statutory processes, but it "is not the sole test for deciding whether an invention is a patent-eligible 'process.'"

With respect to claim 1: appellant's method steps fail the first prong. Appellant's method steps fail the second prong because they do not result in a transformation of a particular article to a different state or thing. Thus, claim 1 is non-statutory.

With respect to claim 13: Appellant's "providing a first display system" may be interpreted to mean a display system such as a billboard that is not tied to a processor. Therefore, claim 13 is also non-statutory since it also fails both prongs of the machine-or- transformation test.

Ground 2 On page 8 of Appeal Brief, Appellant states "The Examiner does not cite any portion of *Kalt* that allegedly is directed to a corresponding revenue generation associated with the signage therein." Examiner notes that while *Kalt* mentions advertising in the background section, it is *Turnpike* that particularly discusses "revenue generation associated with the signage". *Turnpike* discloses:

"Why not make money by erecting its own billboards and renting them? The plan is to build eight two-sided billboards in the stretch between Elizabeth and the Vince Lombardi service area - hardly the Loire Valley to begin with."

This reference discloses that revenue is generated with the rental of billboards. Hence, Turnpike discloses "revenue generation associated with the signage" referring to claim 1, "charging a fee to the entity to allow the advertising information to be maintained on the support by the entity."

Appellant further states that "Kalt is proposing to use existing advertising technology for traffic signs to make them more observable. However, while Kalt compares navigational and advertising technology, Kalt does not propose marrying the two in any manner such as in Appellant's claimed method. Further, it is respectfully submitted that the Examiner's starting premise that Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way is not supported by Kalt's disclosure. Examiner notes that it is the Appellant's claims as stated in the Appellant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*,

211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant's burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Appellant further states that "the Turnpike author argues against the use of a two-sided advertising billboard and thereby highlights the value of the Appellant's invention." Examiner notes that the reference is not teaching away from the claimed invention but rather highlighting the value of two billboards on the highway. Examiner further notes that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) Examiner further notes that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Appellant further states on page 10: "Appellant does not claim to be the inventor of signage that has information on opposite sides. Rather, what is significant about the claimed invention is the strategic placement of two different types of information that allows utilization of potentially previously unused space on supports for navigational signage, to generate revenue." Examiner notes that Appellant argues what is not in the claim. However, even considering such argument, examiner notes that as stated earlier, Turnpike discusses the value of charging a fee for placing two sided billboards on the New Jersey Turnpike.

Appellant further states on page 11 "In spite of the fact that revenue generation is critical in many local governments, to this day signage exists with an unused side and no entity has taken advantage of this opportunity to raise revenue. According to the invention, this unused side of signage can be modified to include advertising information from which a regular and significant stream of revenue can be generated." Examiner notes that Turnpike particularly discusses "revenue generation associated with the signage" and the use of two-sided billboards. Turnpike discloses:

"Why not make money by erecting its own billboards and renting them? The plan is to build eight two-sided billboards in the stretch between Elizabeth and the Vince Lombardi service area - hardly the Loire Valley to begin with."

This discussing discloses that revenue is generated with the rental of billboards. Hence, Turnpike discloses "revenue generation associated with the signage" referring to claim 1, "charging a fee to the entity to allow the advertising information to be maintained on the support by the entity."

Hence, Turnpike discloses charging a fee to the entity to allow the advertising information to be maintained on the support by the entity.

Therefore, the prior art discloses charging a fee to the entity to allow the advertising information to be maintained on the support by the entity.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ALVIN L BROWN/

Examiner, Art Unit 3682

Conferees:

/Arthur Duran/

Primary Examiner, Art Unit 3682

/NAMRATA BOVEJA/

Supervisory Patent Examiner, Art Unit 3682